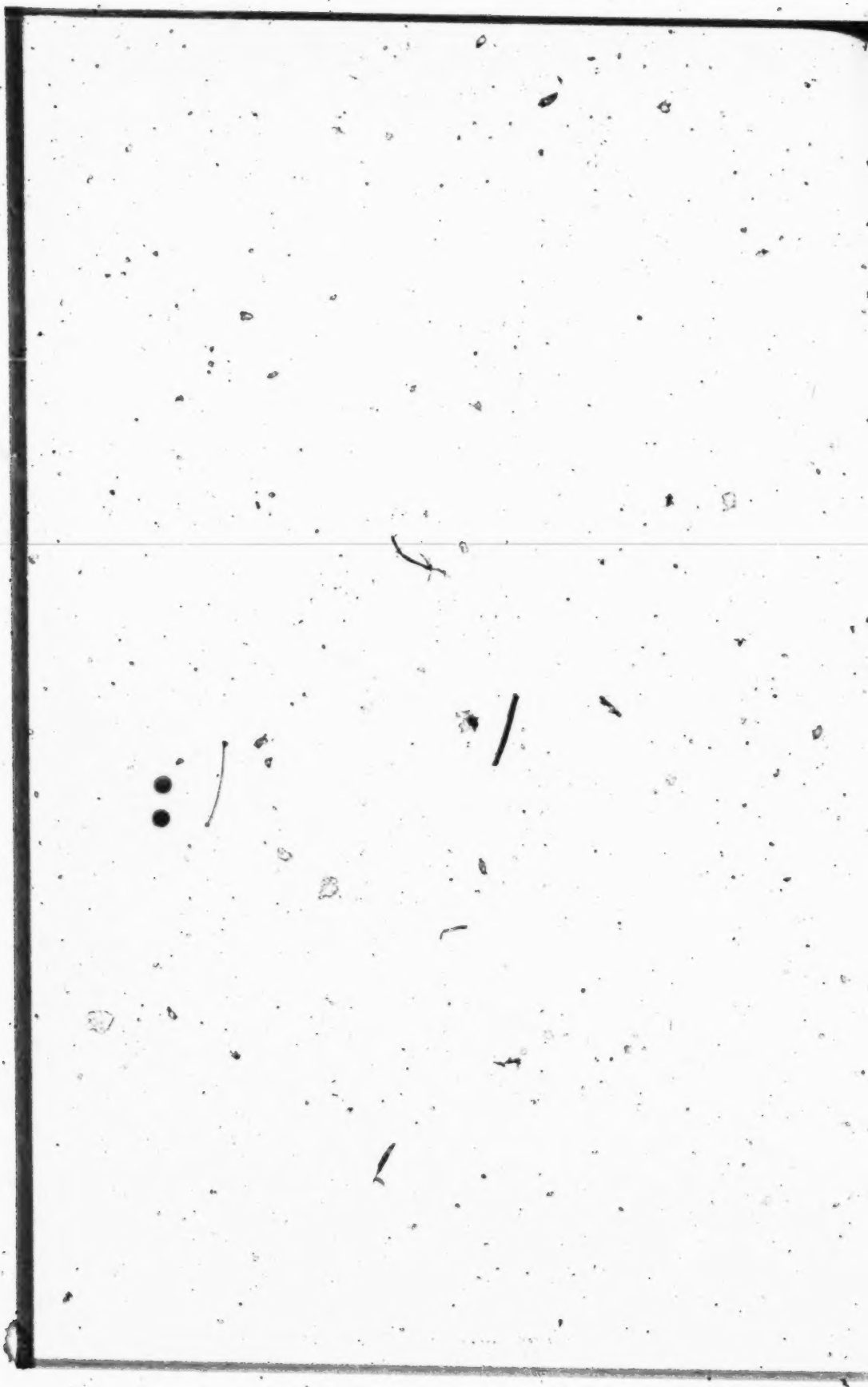

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1933. No. 709.

EASTMAN KODAK COMPANY, EASTMAN KODAK COMPANY OF NEW YORK, and EASTMAN KODAK STORES, INC.,

Petitioners,

v.

CHARLES B. GRAY,

Respondent.

REPLY BRIEF OF PETITIONERS.

WILLIAM H. DAVIS,
GEORGE E. MIDDLETON,
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1933. No. 709.

Eastman Kodak Company, Eastman Kodak Company of New York, and Eastman Kodak Stores, Inc., Petitioners,

v.

Charles B. Gray, Respondent.

IN RE CERTAIN MATTERS TOUCHED UPON IN BRIEF FOR RESPONDENT OPPOSING PETITION FOR CERTIORARI.

On page 4 of the brief filed in opposition to the petition for a writ of certiorari, counsel for respondent say:

"Nothing has been urged except that petitioner thinks the case was wrongly decided on certain technical points. It is not even argued that the case was wrongly decided on the merits and it is not now denied that petitioner wrongfully appropriated and used respondent's invention after it had been disclosed to it in good faith, and that this wrongful appropriation was made under cover of untrue statements calculated to mislead respondent into abandoning his claims."

Subsequently, on pages 7 and 8 of the same brief, counsel for respondent say in elaboration of the foregoing:

"Discussion is unnecessary to demonstrate that there is nothing of a public nature involved in this case, and we respectfully suggest to the Court, that its discretion should not be exercised in a case in which admittedly the petitioner is in the wrong, and relies solely on technical points to sustain its application to this Court. So far from contesting the decision of the Court of Appeals as to the validity of the patent, petitioner for the first time expressly concedes novelty over the prior art (Petitioner's Brief, pp. 14-15).

"As pointed out in the statement of the case, respondent in good faith disclosed his invention to petitioner, sending it a sample of his release; this was returned to respondent by petitioner with a letter (Book of Exhibits, p. 9) in which two statements are contained which two statements the record shows were untrue. The first was that the release which respondent had in-

vented was 'Identical in practically every respect with a release which' petitioner had 'been marketing for some time'; and the second was that 'we are perfecting our patents *covering this construction*.' (Italics ours.)

"The patents in question did not cover the construction of the respondent's device, and the release which petitioner was marketing was not the same nor practically the same as the Court of Appeals decided in a decision the merits of which petitioner does not now contest.

"Even if the technical questions raised were well taken (which is denied), it is respectfully submitted that the discretion of this Court should not be exercised where there is no pretense that the decision on the merits of the case was erroneous."

Counsel for petitioners believe that these statements should not be permitted to remain unchallenged.

Petitioners have not invoked the discretionary power of this Court to grant certiorari upon the ground that the decision of the Circuit Court of Appeals is against the weight of the evidence; that was recognized as a question of no general importance, however important it might be in the instant case. But the case does present important questions of federal law having application beyond the immediate case, as, for example, the scope of review committed by Congress to Circuit Courts of Appeals in actions at law for patent infringement tried by a court without the intervention of a jury (Petition, pp. 8-9).

The petition is directed entirely to those questions of broad importance.

It is disturbing to find this selection of grounds seized upon by counsel for respondent as warrant for the suggestion that this is "a case in which admittedly the petitioner is in the wrong," a case in which "there is no pretense that the decision [of the Circuit Court of Appeals] on the merits of the case was erroneous," and that the decision of the Circuit Court of Appeals is "a decision the merits of which petitioners do not now contest."

Petitioners believe that the decision of the Circuit Court of Appeals is against the weight of the evidence, and intend to urge that point under the third specification of errors assigned, if the writ of certiorari is issued (see Specification of Errors, pp. 12-13 of Petition and Brief).

It is also disturbing to find counsel for respondent bringing before this Court at this time the charge of "wrongful appropriation" of respondent's invention "under cover of untrue statements calculated to mislead respondent into abandoning his claims." To do this, they use the transparent device of stating that the petition for certiorari contains no denial of the charge. There was no occasion for any such denial. Not only is the accusation immaterial on the issues of validity and infringement, but it is a charge which neither of the courts below sustained.

The baselessness of the assertion that "petitioner for the first time expressly concedes novelty over the

prior art" will appear upon reading that part of petitioners' brief to which counsel for respondent refers to support it.

Respectfully submitted,

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GEORGE E. MIDDLETON

CHARLES W. RILEY

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Counsel for Petitioners.